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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,863	01/31/2001	Karl R. Olsen	9218/	2599

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EXAMINER

NGUYEN, NGA B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,863

Applicant(s)

OLSEN, KARL R.

Examiner

Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is the answer to the communication filed on December 10, 2004, which paper has been placed of record in the file.
2. Claims 1-19 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 7, 9-11, 13, and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Kolling et al (hereinafter Kolling), U.S. Patent No. 5,963,925.

Regarding to claim 1, Kolling discloses a method for electronic bill presentation and payment, comprising the entity steps of:

obtaining a plurality of bill files, each bill file associated with a particular billing and a particular billing account maintained at a biller's financial institution, each bill file

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including a plurality of records, each record identifying a particular invoice account and a corresponding balance representing a financial obligation owed by a corresponding customer to the billing entity (column 11, lines 29-42 and column 28, lines 1-16, 27-63; a statement origination workstation (SORG) 208 is operated by coordinating entity 120, biller 102, a Biller Financial Institution (BFI) or a Biller Service Provider (BSP) receives a plurality of batches (equivalent to bill files), each batch including a plurality of statement content records (SCR), each SCR including customer name, customer address, statement data (column 16, lines 45-65; statement data includes customer name, address, account number, type of service, units used, total cost, etc...), consumer's biller account number, etc.);

processing records in each bill file by:

obtaining a routing address associated with a customer's financial institution where the corresponding customer maintains an account (column 28, line 53-column 29, line 33; sorting all of the statement content records by SGEN identifier, batches of records sorted by SGEN identifier are routed to the appropriate physical SGEN; column 13, lines 1-13; SGEN is located at the Customer Financial Institution (CFI));

obtaining customer account identification information identifying the corresponding customer's account at the customer's financial institution (column 27, lines 4-6; SORG retains the CSP identifier, the DSP account number, biller identifier, etc.);

assembling a bill packet corresponding to the bill record, the bill packet including information from the corresponding bill record and the customer's account

identification information (column 13, lines 13-32; SGEN assembles each electronic statement by merging the appropriate template from a particular biller with standard statement data representing a customer of that biller); and

transmitting the bill packet to an electronic repository corresponding to the customer's financial institution using the associate routing address (column 13, lines 15-17; transmitting the electronic statement to CFI); and

processing the bill packets received by each electronic repository by:

sorting the received bill packets by customer's account information (figure 12 and column 31, lines 35-55; consumer login to the bank account maintained at the Midwest Federal Bank, a list of subscriptions displayed, including Cyber Bell, Great Northern bank, Network Gas & Electric, and ABC Cable);

assembling a bill presentation file containing information from the received bill packets for each customer account (column 29, lines 45-60; SGEN executes statement generation program, the electronic statement is represented in PDF file); and

electronically presenting each bill presentation file for viewing and electronic bill payment (figure 16 and column 32, lines 25-45; a sample make payment screen is displayed, make payment screen includes button for viewing accounts, payments, payee, etc.); .

Regarding to claim 7, Kolling discloses the step of assembling a bill packet further comprises the step of encrypting the bill packet (column 33, lines 30-40).

Regarding to claim 9, Kolling discloses the step of assembling a bill packet further comprises the step of attaching to the bill record a Universal Resource Locator of a

server operated by the billing entity to enable the customer to find detailed billing information (column 19, lines 20-30; the summary section could include a URL for customer access to detailed transaction records).

Regarding to claim 10, Kolling discloses the step of electronically presenting each bill presentation file for viewing and electronic bill payment further comprises the steps of: providing securing for accessing the bill presentation file to ensure the privacy of any information displayed; providing security to ensure the confidentiality of any payment information received (figure 11 and column 31, lines 19-35; after clicking the login hot spot 866, the customer would be challenged for identification, in a login screen the customer might be asked to supply a user name, a code number or other authentication).

Regarding to claims 11 and 13, Kolling discloses the steps of electronically presenting each bill presentation file for viewing and electronic bill payment includes receiving authorization to debit a direct deposit account at the customer's financial institution and debiting the customer's direct deposit account (figure 16, "Method of Payment" 946).

Regarding to claims 15 and 17, Kolling discloses recording the payment by the customer in a customer payment warehouse database (figure 12 and column 31, lines 45-45, history button 879 allowing customer to view history invoices or payments) and recording the payment to billing entity in a bill payment warehouse database (column 9, lines 23-25, biller's account receivable database).

Regarding to claim 16, Kolling discloses sending an automated payment to the biller's financial institution that originated the bill; crediting the billing account owned by the biller at the biller's financial institution; and notifying the billing entity that the bill has been paid (column 9, lines 14-25).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-4, 8, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al (hereinafter Kolling), U.S. Patent No. 5,963,925.

Regarding to claim 2, Kolling discloses obtaining a routing address comprises the steps of: obtaining a payment made by the customer remunerated to the billing entity (column 30, lines 5-18, customer makes payment by check or by electronic bill payment). Kolling does not disclose data mining the payment to obtain customer's financial institution data that distinctly identifies a customer's financial institution. However, data mining the payment to obtain customer's financial institution data that distinctly identifies a customer's financial institution is well known in the art. For example, Kolling does disclose customer can makes payment by check directly to the biller or by submitting electronic payment to CFI so that payment information is

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transmitted back to biller (column 30, lines 5-18). Thus, it is obvious that biller can easily to obtain customer's financial institution data such as CFI identifier, CFI routing and transit number, etc...because such data included in the check. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Kolling's for the purpose of providing more convenient to the biller to obtain customer's financial institution data from the payments made by customers in order to encourage customers participating in electronic bill payment.

Regarding to claims 3-4, Kolling does not teach the customer's financial institution data include an American Bankers Association routing and transit number or an International Organization for Standardization issuer identification number. However, Kolling does teach customer can makes payment by check directly to the biller or by submitting electronic payment to CFI so that payment information is transmitted back to biller (column 30, lines 5-18). Moreover, American a Bankers Association routing and transit number is well known authentication data contained in a check, an International Organization for Standardization issuer identification number is well known authentication data contained in credit transaction. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Kolling's to include the feature above for the purpose of providing more easily and convenient for the biller to transmit electronic bill to the appropriate customer's financial institution.

Regarding to claim 8, Kolling does not disclose the step of processing the bill packets received by each electronic repository further comprises the step of decrypting

the bill packet. However, Kolling does teach all financial transaction messages are transmitted in encrypted form, thus the messages must be decrypted in order to be viewed by any entity such as the financial institution or the customer, moreover, decrypting messages using a proprietary decryption technique is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Kolling's for the purpose of providing the security to prevent the unauthorized user to gain access to the security information.

Claim 18 contains similar limitation found in claims 1 and 2 above, therefore, are rejected by the same rationale.

Regarding to claim 19, Kolling discloses a system for electronic bill present and payment, comprises the steps of:

obtaining a payment made by a customer remunerated to a billing entity (column 30, lines 5-18, customer makes payment by check or by electronic bill payment);

associating the customer's financial institution data with a routing address (column 29, lines 1-10, CSP has a remote mail station identifier to enable the data to be sent to the correct CSP);

transmitting a bill packet to an electronic repository corresponding to the customer's financial institution using the associated routing address (column 29, lines 1-10, the batches of records sorted by SGEN identifier are routed to the appropriate physical SGEN and then on the appropriate DSP, the SGEN identifier is mapped to a remote mail station identifier to enable the data to be sent to the correct CSP).

Kolling does not disclose data mining the payment to obtain customer's financial institution data that distinctly identifies a customer's financial institution. However, data mining the payment to obtain customer's financial institution data that distinctly identifies a customer's financial institution is well known in the art. For example, Kolling does disclose customer can makes payment by check directly to the biller or by submitting electronic payment to CFI so that payment information is transmitted back to biller (column 30, lines 5-18). Thus, it is obvious that biller can easily to obtain customer's financial institution data such as CFI identifier, CFI routing and transit number, etc...because such data included in the check. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Kolling's for the purpose of providing more convenient to the biller to obtain customer's financial institution data from the payments made by customers in order to encourage customers participating in electronic bill payment.

8. Claims 5, 6, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al (hereinafter Kolling), U.S. Patent No. 5,963,925, in view of Chang, U.S. Patent No. 5,848,400.

Regarding to claims 5-6, Chang discloses obtaining a routing address comprises the steps of: associating the customer's financial institution with a globally unique identifier; receiving an Internet Protocol address corresponding to the globally unique identifier; loading information into a look-up table database that correlates the customer's financial institution with the Internet Protocol address (column 5, lines 13-22; mapping financial institution identifications into financial transaction server network

identifiers, loading network identifiers into a routing table 231). Chang does not teach registering the globally unique identifier with an Internet Domain Name Service. However, Chang teaches each customer's financial institution has a network identifier, moreover, in order to have a network identifier, it is well known in the art that each customer's financial institution must register with an Internet Domain Name Service. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Kolling's to adopt the teaching of Chang above for the purpose of obtaining a network identifier for each customer's financial institution in order to route the electronic bills to the customer's financial institution.

Regarding to claims 12 and 14, Kolling does not disclose the step of electronically presenting each bill presentation file for viewing and electronic bill payment includes authorization to charge a credit card of the customer and charging the customer's credit card. However, Chang discloses the step of electronically presenting each bill presentation file for viewing and electronic bill payment includes authorization to charge a credit card of the customer and charging the customer's credit card (column 5, lines 43-60 and column 7, lines 50-67). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Kolling's for the purpose of providing more convenient to the customer to submit payment using credit card.

Conclusion

9. Claims 1-19 are rejected.

10. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Kolling et al (US 5,920,847) discloses an electronic bill pay system wherein participating consumers pay bills to participating billers through a payment network.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (703) 306-2901. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-1113.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
C/o Technology Center 3600
Washington, DC 20231

Or faxed to:

(703) 872-9326 (for formal communication intended for entry),

or

(703) 308-3691 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

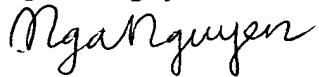
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Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen

A handwritten signature in cursive script that reads "Nga B. Nguyen".

February 23, 2005